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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,895	02/13/2006	Jurgen Damm	18064	6365

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CNH AMERICA LLC  
INTELLECTUAL PROPERTY LAW DEPARTMENT  
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NEW HOLLAND, PA 17557

EXAMINER
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MITCHELL, JOEL F

ART UNIT	PAPER NUMBER
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3671

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12/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,895	<b>Applicant(s)</b> DAMM ET AL.	
	<b>Examiner</b> Joel F. Mitchell	<b>Art Unit</b> 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informality: the specification does not include descriptions of Figs. 5 and 6. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 states alternative wall thicknesses in lines 8-9 and 10-12. This is inconsistent with the specification and the dependent claims (most notably claim 2) since a rear end plate of variable thickness is not shown or claimed. For examination purposes lines 8-12 of claim 1 are being treated as though they read:

"the rear end plate exhibits a small wall thickness in use with a rear mounted piece of equipment of a high weight or the rear end plate exhibits a greater wall thickness in use with a rear-mounted piece of equipment of a low weight or without any rear-mounted equipment;"

### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Applicant is advised that should claims 3 and 4 be found allowable, claims 6 and 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wykhuis et al (US 4,580,811).**

9. With respect to claim 1, Wykhuis discloses a vehicle (10) having a rear frame including left (14) and right (12) longitudinal beams, each having a rear end, and providing for the components or subassemblies of a rear counterweight, lights and a bumper, the improvement comprising:

the bumper and the rear counterweight are comprised of a generally flat elongate rear end plate (30) having opposing outer end regions and extending across the entire width of the grader (Fig. 1);

the rear end plate exhibits a greater wall thickness in use without any rear-mounted equipment (addition of weights 52 and removal of spacers 48 leading to a greater wall thickness);

the rear end plate viewed in the direction of travel of the grader constitutes the rearmost part of the rear frame (seen in Fig. 2); and

tail lights are built into openings (col. 1, lines 65-68) in the rear end plate positioned in the outer end regions (Fig. 1).

10. Wykhuis does not explicitly disclose a road grader. Wykhuis discloses a rear counterweight assembly for a vehicle. This vehicle frame appears similar to that of road graders and is capable of being a road grader. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the assembly of Wykhuis on a road grader. The motivation being "to provide a counterweight assembly which does not hinder the function of the vehicle nor disturb the styling lines thereof." (col. 1, lines 26-28)

11. Wykhuis does not explicitly disclose backup/brake and flasher lights. Wykhuis discloses the assembly housing "a pair of taillights having lenses 32." (col. 1, line 66) The Examiner takes official notice that backup/brake and flasher lights being built into a bumper assembly is well known in the vehicle art. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the assembly of Wykhuis with backup/brake and flasher lights. The motivation being to signal braking and turning.

12. With respect to claim 2, Wykhuis discloses the assembly wherein the rear end plate (30) is formed as one piece (shown as one piece in Fig. 1).

13. With respect to claims 3, 5, and 6, Wykhuis discloses the assembly wherein the rear ends of the left longitudinal beam (14) and the right longitudinal beam (12) are joined to a rear transverse beam (16).

14. With respect to claims 4 and 7, Wykhuis discloses the assembly wherein the rear end plate (30) is removably attached (via 38, 42, 46, 50; shown exploded and detached in Fig. 1) to the rear transverse beam (16).

**15. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luttrell (US 3,853,231).**

16. With respect to claim 8, Luttrell discloses a road grader (10) comprising:

a wheel-supported main frame (16) having a front end and an opposing rear end (18) as determined by the normal direction of travel, the main frame comprised of joined front and rear frames (shown as articulated in Fig. 1);

an engine (14) and a driver's cab (seen in Fig. 1) supported on said main frame;

a vertically adjustable ground-engaging blade (at 12) supported by said main frame;

the rear frame (18) having left (20) and right (22) longitudinal beams generally parallel and in the general same horizontal plane (seen in Fig. 2), each with a rear end;

a generally flat elongate rear end plate (48) jointed (via 24) to the rear end of each of the right and left longitudinal beams;

the rear end plate constituting the rearmost part of the rear frame (seen in Fig. 1) and extending generally the width of the road grader (seen in Fig. 2); and

the rear end plate having openings (apertures of col. 3, lines 59-61) therethrough to accommodate the attachment of rear-mounted equipment.

17. With respect to claim 9, Luttrell discloses the road grader wherein the rear end plate (48) is formed as one piece (shown as one piece in Fig. 2).

18. With respect to claim 10, Luttrell discloses the road grader wherein the rear ends of the left longitudinal beam (20) and the right longitudinal beam (22) are joined to a rear transverse beam (24).

**19. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luttrell as applied to claim 8 above, and further in view of Wykhuis.**

20. Luttrell discloses the tool with regard to claim 8. Luttrell does not disclose openings for lights in the rear plate. Wykhuis discloses a rear counterweight assembly wherein the rear end plate has opposing outer end portions and openings through the outer end portions and taillights are fitted therein (col. 1, lines 65-68).

21. Wykhuis does not explicitly disclose backup/brake and flasher lights. Wykhuis discloses the assembly housing "a pair of taillights having lenses 32." (col. 1, line 66) The Examiner takes official notice that backup/brake and flasher lights being built into a bumper assembly is well known in the vehicle art. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the assembly of Wykhuis with backup/brake and flasher lights. The motivation being to signal braking and turning.

22. Luttrell and Wykhuis are analogous because they both disclose rear counterweight assemblies for vehicles. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the road grader of Luttrell with the rear lighting capabilities as taught by Wykhuis. The motivation being to signal braking and turning, as well as to provide a convenient location for electrical connections to rear-mounted equipment



**23. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luttrell in view of Wykhuis as applied to claim 11 above, and further in view of Latterman (US 3,490,787).**

24. Luttrell and Wykhuis disclose the road grader with regard to claims 8 and 11. They do not explicitly disclose the rear end plate being made of steel. Latterman discloses a tractor bumper and counterweight assembly wherein the end plate (7, as well as associated members 2 and 11) are made of heavy steel (col. 2, lines 18-24).

25. Luttrell, Wykhuis, and Latterman are analogous because they all disclose counterweight assemblies for vehicles. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the road grader disclosed by Luttrell and Wykhuis with a steel rear end plate as taught by Latterman. The motivation being to have the plate withstand normal wear as well as wear encountered in using the plate as a bumper for pushing other vehicles or implements (Latterman, col. 2, lines 18-22).

### ***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joel F. Mitchell whose telephone number is (571) 272-7689. The examiner can normally be reached on Mon-Fri 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on (571) 272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Thomas B. Will**  
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12/17/7

Joel F. Mitchell  
Examiner  
Art Unit 3671